



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
---------------	-------------	----------------------	---------------------

08/528.538 09/14/95 KANEKO

005514 MMD1/0926
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112

N 35.61548

EXAMINER

ART UNIT PAPER NUMBER

32

2841

DATE MAILED: 09/26/00

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 7/24/00 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s) days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☐ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

- ☒ Claims 1-3, 22, 23 are pending in the application.
Of the above, claims are withdrawn from consideration.
- ☐ Claims have been cancelled.
- ☐ Claims are allowed.
- ☒ Claims 1-3, 22, 23 are rejected.
- ☐ Claims are objected to.
- ☐ Claims are subject to restriction or election requirement.
- ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
- ☒ The proposed drawing correction, filed 3/4/98, has been ☒ approved; ☐ disapproved (see explanation).
- ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☒ been received ☐ not been received ☐ been filed in parent application, serial no. ; filed on
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

Jeffrey Gallin
Senior Patent Examiner
Telephone: 2800

EXAMINER'S ACTION

DETAILED ACTION

Treatment of Claims Based on Prior Art

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 23, 2-3 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yurek et al. (US 5545613, hereafter referred to as Yurek) and Shi et al. (Swagged Superconducting Wires, hereafter Shi) and Paranthaman et al. (Formation of Anisotropic Tl-1212, Tl-2212, Tl-1223 and Tl-2223 Particles using Aerosol Flow Reacted Powders, hereafter Paranthaman).

Yurek discloses a wire of a superconductive material where the grains of the material are compact and adhered together (sintered and compact) with silver (claim 2) filling the voids of the superconductive material in Example 7 prepared with the oxide-metal composite of Example 2, placed in the inside of a metal tube (conductive material) and composing a wire, column 3 at lines 12-23, 63-67 and column 4 at lines 1-3.

Yurek discloses the claimed invention except the composition of the conductive material, thereby the higher melting point of the conductive material. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to make the conductive material of the Yurek wire copper, gold or aluminum (claim 3), or an alloy thereof (claim 22), because it is well known in the superconducting arts to make the outer sheath of wires from these metals and their

alloys, as evinced by Shi and Paranthaman. Selecting the conductive material as such necessarily makes the melting point of the conductive material higher than the solidified metallic material, silver (claim 23).

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yurek, as applied to claim 23 above, and Den et al. (US **5,512,538**, hereafter referred to as Den).

Yurek discloses the claimed invention except for the superconducting oxide being Ln-Sr-Cu-M-O. Yurek does state that the invention is applicable to any superconducting oxide, column 2 at lines 43-44. Den discloses this type of superconducting oxide, reference the abstract.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the superconductive oxide of Den to provide the superconductive material of Yurek, because this type of superconducting oxide is one of many oxides known in the art for making superconductive wires.

Response to Arguments

4. Applicant's argument has been carefully reviewed, but is not persuasive. Applicant alleges that the rejection is improper because a reference stating that use of copper, gold or aluminum as an outer tube is well known. Applicant challenges the commonness of gold, copper or aluminum as an outer tube, because a reference is not provided. First, applicant errs in asserting that the rejection is improper; a rejection based on common knowledge is proper even if a reference is not provided. Second, in challenging what examiner considers well know, applicant has not provided adequate information to raise reasonable doubt, on its face, regarding examiner's position. Applicant merely

Serial Number: 08/528538
Art Unit: 2841

4

objects to the position without giving any reason. Third, in compliance with applicant's request, examiner has cited a couple of references in support of her position. As can be clearly seen, the knowledge is old in the art.

5. MPEP 2144.03 states:

If the examiner adds a reference to the rejection in the next action after applicant's rebuttal, the newly cited reference, if it is added merely as evidence of the prior well known statement, does not result in a new issue and thus the action can potentially be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the rejection is made final.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Serial Number: 08/528538
Art Unit: 2841

5

Closing

6. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Examiner Kamand Cuneo at (703) 308-1233. Examiner Cuneo's supervisor is Examiner Jeffrey Gaffin whose telephone number is (703) 308-3301.



K. Cuneo
Patent Examiner Group 2841
September 25, 2000



Jeffrey Gaffin
Supervisor, Patent Examiner
Technology Center 2800